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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/821,027 03/19/97 VOIT

E 680-189

020277
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

WM02/0522

EXAMINER

KWOKH, T	ART UNIT	PAPER NUMBER
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2663

DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/821,027

Applicant(s)

VOIT et al.

Examiner

Jasper Kwoh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Mar 12, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1, 2, 4-21, 23, and 24 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 2, 4-21, 23, and 24 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) Other: _____

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DETAILED ACTION

Response to Arguments

1. In view of the resubmission of appeal brief filed on 3/12/01, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The disclosure is objected to because of the following informalities: the application information on page 1 lines 2-9 and page 7 line 19 should be updated.

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Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-2, 4, 6-9, 21 and 23-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Farris.

Regarding claims 1 and 21, Farris discloses a method and corresponding network comprising determining QoS; comparing QoS obtained in the determining step with a predetermined threshold level; in response routing to a second one of the station if level exceeded; and routing the telephone call to the second station through PSTN if level not exceeded (col. 4, ll. 47-65).

Regarding claims 2, 4, 6-9 and 23-24, Farris discloses entering an unique service code (inherent to have a code to notify the system when to perform desired operations); PSTN is an AIN that includes ISCP and CPRs (col. 4, 53-56); exchanging signaling messages (i.e. col. 7, ll. 2-15); data network is the internet (i.e. fig. 3); and gateway routers (i.e. 20, col. 9, ll. 60-67;

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inherent to determine if station not busy and establish connection); also network including assembling and deassembling packet and compress and decompress data (i.e. fig. 4-8).

6. Claims 1-2, 4-21 and 23-24 are provisionally rejected under 35 U.S.C. 102(e) as being clearly anticipated by copending Application No.08/815,361 which has common assignee and at least one common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. The copending application discloses monitoring the QoS of existing internet during communications of a voice call and level of service are defined with respect to a threshold level stored in the CPR in the AIN ISCP. Routing is changed depending on the quality. Therefore, present application reads on the earlier filed copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 17 USPQ2d 1885 (Fed. Cir. 1991).

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5, 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris.

Farris does not specifically disclose interexchange carrier identity is specified in the CPR; threshold is stored in the CPR; triggering the ISCP in response to the unique service code or off-hook condition; and dialed information of area code and phone number correspond to subscriber CPR. However, Farris shows user's record is stored in CPR (i.e. col. 4, l. 53); also triggering ISCP (i.e. col. 8, ll. 30-52). Therefore, it would have been obvious to an ordinary person skilled in the art at the time of the invention to specify interexchange carrier identity in the CPR; store threshold in the CPR; triggering the ISCP in response to the unique service code or off-hook

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condition; and dialed information of area code and phone number correspond to subscriber CPR in order for the system to function harmoniously with the specific user and properly and effectively direct the call using the resources available already.

9. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris in view of Jones et al.

Farris does not specifically disclose measuring the time duration; ascertaining variance; exceed threshold if longer; not exceed if less; and sending sample packet. However, Jones et al. sends test packets (i.e. 804; ping, test packet echo, etc.), measures round trip duration/delay and ascertain variance (i.e. fig. 9, 900, 902) and routing to the PSTN if a bandwidth level is below a predetermined threshold (i.e. abstract). Therefore, it would have been obvious to an ordinary person skilled in the art at the time of the invention to include the strategies of measuring, routing and sending as taught by Jones with the method of Farris in order to monitor delay and analyze the situation.

Response to Arguments

10. Applicant's arguments with respect to claims 1-2, 4-21 and 23-24 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasper Kwoh whose telephone number is (703) 305-0101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen, can be reached on (703) 308-5340.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

~~(703) 305-3988~~ (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

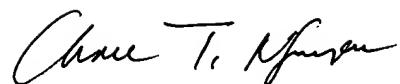
Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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Jasper Kwoh



May 18, 2001

CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
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